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TOWNSEND and TOWNSEND and CREW LLP

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PATENT
Attorney Docket No. 021737-000110US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No. 2173
JEFFRY J. GRAINGER et al.	Examiner: Mary Da Zhi Wang Cheung
Application No.: 09/872,764	Technology Center/Art Unit: 3621
Filed: June 1, 2001	APPELLANTS' BRIEF UNDER 37 CFR §41.37
For: COMPUTER-IMPLEMENTED METHOD FOR SECURING INTELLECTUAL PROPERTY	

Via EFS Web
Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal mailed on January 11, 2007 for the above-referenced application, the Appellants submit this Brief on Appeal (the "Brief"). A notice of decision of the pre-appeal brief review panel was mailed March 28, 2007, setting the deadline for filing this Brief at April 28, 2007. This Brief is submitted with a Petition for a five-month extension of time under 37 CFR 1.136, extending the deadline for filing the Brief to September 28, 2007. Accordingly, this Brief is believed to have been timely filed.

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1. REAL PARTY IN INTEREST

FTF Technologies, Inc., of Boise Idaho, is the real party in interest. Corporation Service Company, of Wilmington, Delaware, has a majority ownership interest in FTF Technologies, Inc.

2. RELATED APPEALS AND INTERFERENCES

The following appeals may be related to, directly affect, be directly be affected by, or have a bearing on the Board decision in this appeal:

- U.S. Patent Application No. 09/919,764 (no appeal number assigned)
- U.S. Patent Application No. 09/919,768 (no appeal number assigned)
- U.S. Patent Application No. 09/996,338 (Appeal No. 2007-0776)
- U.S. Patent Application No. 09/996,341 (no appeal number assigned)
- U.S. Patent Application No. 09/997,311 (no appeal number assigned)

3. STATUS OF CLAIMS

Claims 1-17, 38 and 39 are currently pending in this application. Claims 18-37 have been canceled. All pending claims stand finally rejected pursuant to a Final Office Action mailed August 18, 2006. A copy of the claims as rejected is provided in the **Claims Appendix**, infra**.** Claims 1, 38 and 39 are independent claims.

Claims 1-3, 38 and 39 stand rejected under 35 U.S.C. § 102(a) as being anticipated by ePAVE User Guide, published by U.S. Patent and Trademark Office on January 12, 2000 (hereinafter, "ePAVE" or the "ePAVE reference"). Claims 4-8 and 11 stand rejected under § 103(a) as being unpatentable over ePAVE, claims 9 and 10 stand rejected under § 103(a) as being unpatentable over ePAVE in view of USP 5,982,989 (hereinafter, "Hsu"), claims 12-14 stand rejected under § 103(a) as being unpatentable over ePAVE in view of USP 6,182,078 (hereinafter, "Whitmyer"), and claims 15-17 stand rejected under § 103(a) as being unpatentable over ePAVE, in view of U.S. Patent Application Specification Authoring Guide for WordPerfect

XML template, published by U.S. Patent and Trademark Office on December 14, 1999 (hereinafter, "XML Guide").

The rejections of each of claims 1-17, 38 and 39 are believed to be improper and are the subject of this appeal.

4. STATUS OF AMENDMENTS

An Amendment filed September 27, 2007 amended claims 1, 38 and 39 to place the claims in better form for appeal. As of the filing date of this Brief, the Examiner has not yet admitted the amendments. The amendments made by the September 27, 2007 Amendment are reflected in the **Claims Appendix**, infra

5. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention relates generally to computer programs for generating patent applications, as well as methods and systems that implement such computer programs. Merely by way of example, claim 1 is directed to a computer-implemented method for securing intellectual property rights. (Application, p. 2, ll. 8-9; p. 5, ll. 21-29). The method of claim 1 comprises providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out. (Application, p.1, ll. 11-12; p. 15, ll. 17-20; p. 34, l. 31-33; p. 35, ll. 1-3; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields))

The method of claim 1 further comprises actively prompting a user of the client computer to provide information corresponding to an invention into pre-selected fields of the electronic invention disclosure form. (Application, p.1, ll. 15-17; p. 15, ll. 17-20; p. 16, ll. 1-10; p. 41, ll. 15-16; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields)) In accordance with the method of claim 1, the server receives a filled-out invention disclosure in electronic form. (Application, p. 16, ll. 11-16; p. 32, l. 10; p. 41, l. 17; p. 44, ll. 1-2) The invention disclosure is then automatically converted into a format of a patent application. (Application, p.1, ll. 18-21; p. 16, ll. 17-27; p. 43, ll. 7-31; p. 44, l. 25-28) This conversion is performed in response to the server

computer's reception of a single click instruction input by the user on the client. (Application, p. 17, ll.13-23)

Claim 38 is directed to computer program embodied on one or more computer readable medium. (Application, p. 8, ll. 23-25; p. 9, ll. 1-7, p. 10, ll. 9-20) The computer program comprises instructions executable by one or more computers. (Application, p. 3, ll. 9-10; p. 9, ll. 1-7, p. 10, ll. 9-20) In accordance with claim 38, the instructions are executable by the computer(s) to provide, from a first server computer to a client computer, an electronic invention disclosure form to be filled out. (Application, p.1, ll. 11-12; p. 15, ll. 17-20; p. 34, l. 31-33; p. 35, ll. 1-3; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields)) The instructions are further executable to actively prompt a user of the client computer to provide information corresponding to an invention into pre-selected fields of the electronic invention disclosure form (Application, p.1, ll. 15-17; p. 15, ll. 17-20; p. 16, ll. 1-10; p. 41, ll. 15-16; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields)), and to receive a filled-out invention disclosure in electronic form on the first server. (Application, p. 16, ll. 11-16; p. 32, l. 10; p. 41, l. 17; p. 44, ll. 1-2) The instructions are also executable by the computer(s) to automatically convert the invention disclosure form into a format of a patent application, in response to a single click instruction input by the user on the first client and received by the server. (Application, p.1, ll. 18-21; p. 16, ll. 17-27; p. 17, ll.13-23; p. 43, ll. 7-31; p. 44, l. 25-28)

Claim 39 is directed to a computer server for securing intellectual property rights. (Application, p.2, ll. 8-9; p. 5, ll. 21-29) The computer server of claim 39 comprises a processor and a computer readable medium, which comprises instructions executable by the processor. (Application, p. 2, ll. 8-9; p. 3, ll. 9-10; p. 8, ll. 23-28; p. 9, ll. 1-7, p. 10, ll. 1-20). The instructions are executable by the processor to provide to a client computer an electronic invention disclosure form to be filled out Application, p.1, ll. 11-12; p. 15, ll. 17-20; p. 34, l. 31-33; p. 35, ll. 1-3; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields)), to actively prompt a user of the client computer to provide information corresponding to an invention into pre-selected fields

of the electronic invention disclosure form (Application, p.1, ll. 15-17; p. 15, ll. 17-20; p. 16, ll. 1-10; p. 41, ll. 15-16; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields)), to receive from the client computer a filled-out invention disclosure in electronic form (Application, p. 16, ll. 11-16; p. 32, l. 10; p. 41, l. 17; p. 44, ll. 1-2), and to automatically convert the invention disclosure form into a format of a patent application in response to a single click instruction input received from the user on the client computer. (Application, p.1, ll. 18-21; p. 16, ll. 17-27; p. 17, ll.13-23; p. 43, ll. 7-31; p. 44, l. 25-28)

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-3, 38 and 39 are anticipated under 35 U.S.C. § 102(a) over ePAVE

2. Whether claims 4-8 and 11 are unpatentable under 35 U.S.C. § 103(a) over ePAVE.

3. Whether claims 9 and 10 are unpatentable under 35 U.S.C. § 103(a) over ePAVE, in view of Hsu.

4. Whether claims 12-14 are unpatentable under 35 U.S.C. § 103(a) over ePAVE, in view of Whitmyer.

5. Whether claims 15-17 are unpatentable under 35 U.S.C. § 103(a) over ePAVE, in view of XML Guide.

7. ARGUMENT

1. The rejections of claims 1-3, 38, and 39 under 35 U.S.C. § 102(a) should be reversed.

To support a rejection under 35 U.S.C. § 102, the Examiner is obligated to establish that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (quoting *Verdegaal Bros. v.*

Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (quotation marks omitted). Moreover, although ipsis verbis disclosure of the claim elements is not required to establish anticipation, "[t]he elements must be arranged as required by the claim." *Id.*

The Final Office Action rejected claims 1-3, 38 and 39 under § 102(a) as being anticipated by ePAVE, implicitly asserting that ePAVE teaches each element of the rejected claims. The Appellant respectfully submits that the Examiner is mistaken in that regard, and that ePAVE in fact fails to teach, or even to suggest, each element of any claim rejected under § 102. In particular, it is worth noting that the present claims and ePAVE, respectively, are directed to solutions to two very different problems.

The rejected claims are directed to solutions for obtaining with a client system, information from an inventor (or another) that can be used, at a server system, to generate a patent application automatically, in response to a single click instruction input.

In contrast, the ePAVE program itself (the subject of the ePAVE reference relied upon by the final Office Action) is a software tool provided by the USPTO for submitting patent applications that already have been prepared (presumably using a manual process), and the ePAVE reference correctly describes that program as a tool that merely puts a pre-existing patent application in a proper data format for electronic filing. *See, e.g.*, ePAVE, at 39 ("The Attachments Tab allows you to attach your authored utility patent specification XML to your submission." (emphasis added)). The ePAVE reference nowhere teaches, or even suggests, that the ePAVE software might be used to generate a patent application automatically from a filled-out invention disclosure form. Accordingly, ePAVE teaches few, if any, elements of even the independent claims rejected under § 102.

a) Claim 1

For example, the final Office Action fails to show that ePAVE discloses many of the elements of claim 1, including without limitation, " providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out, " "receiving a filled-out invention disclosure in electronic form on the first server," and "automatically converting the

invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server." Accordingly, the final Office Action fails to establish that ePAVE anticipates claim 1, and the rejection of claim 1 under § 102 should be reversed.

(1) ePAVE fails to teach or suggest "an electronic invention disclosure form to be filled out"

Consider, for example, claim 1, which recites, inter alia, "providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out." The Examiner fails to demonstrate that ePAVE teaches or suggests this element. The final Office Action cites pages 1, 9, 12 and 17-21 as disclosing this element, Final Office Action, at 4, and argues that "ePave teaches an electronic invention disclosure forms to be filled out, such as patentee information, and attorney or agent information." Final Office Action 2 (citing ePAVE at 19-21).

Even assuming ePAVE discloses the functionality described by the Examiner (an electronic form for providing biographical information associated with a patent application), the mere ability to receive, on an electronic form, biographical information about a patentee and/or attorney does not teach or suggest that the ePAVE software provides any facility for an inventor to use that form to disclose an invention, functionality that is inherently required by the term "invention disclosure form." Nowhere does ePAVE disclose any ability to provide an electronic form for a user to disclose an invention, rather than mere biographical information. Indeed, Appendix A of ePAVE provides a "[d]etailed [d]escription of [s]creens and fields." ePAVE at 51. None of the listed screens or fields even remotely indicates that an invention disclosure might be stored in any of the ePAVE forms. *See* ePAVE at 51-54.

Consequently, no reasonable interpretation of ePAVE allows for the construction of that reference as teaching "providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out." Since this feature is required by claim 1, ePAVE fails to anticipate claim 1, and for at least this reason, ePAVE fails to anticipate claim 1, and the rejection of claim 1 under § 102(a) should be reversed.

(2) ePAVE fails to teach or suggest the client-server relationship required by claim 1.

Claim 1 also recites that the electronic invention disclosure form is "provid[ed], from a first server computer to a client computer," as well as "receiving a filled-out invention disclosure in electronic form on the first server." Even assuming that ePAVE could be interpreted to teach an electronic invention disclosure form (which, as noted above, it cannot), ePAVE still would fail to teach or suggest that the form is provided from a server computer to a client computer and that a filled-out disclosure is received by the same server, as required by claim 1.

ePAVE fails, for several reasons, to teach this combination of elements. First, ePAVE provides no teaching or suggestion that an electronic invention disclosure form might be provided from a server computer to a client computer. In fact, ePAVE expressly teaches the opposite, that the ePAVE software is a locally installed on a user's computer as a local application, rather than a client-server application: "The ePAVE software is a client application, and the current version must be installed on a local machine." ePAVE, at 14. Hence, assuming the ePAVE software provides any type of electronic invention disclosure form, it is provided from the client itself, not from a server computer to a client computer.

In addressing the client-server relationship required by claim 1, the final Office Action states,

> Examiner believes that ePave software program can be downloaded from USPTO related website to the user computer so that the user can create electronic version of a patent application (page 12); thus the ePave software program is provided by/from a first server computer, which is the USPTO server system.
>
> . . . Examiner believes that ePave teaches electronically submitting a filled-out patent application by a user, and the USPTO's computer will then send acknowledgement receipt (see page 29 and 49), that correspond to the limitation 'receiving a filled-out invention disclosure form on a first server'.

Final Office Action, at 2-3. The Appellants respectfully submit that, even assuming the ePAVE program itself can be downloaded from a server computer at the USPTO, the solitary fact that the software can be downloaded and installed locally does not teach or suggest providing an electronic invention disclosure form from a server computer. Rather, it is the ePAVE software itself, once it has been installed on the user's computer, that provides the electronic invention

disclosure form, not any server at the USPTO. Hence the fact that the ePAVE software can be downloaded from a server is immaterial to the question of whether the ePAVE reference discloses the provision of an electronic disclosure form from a server computer to a client computer (as claim 1 requires), and the Appellants respectfully submit that the ePAVE reference contains no such disclosure.

Second, claim 1 requires that the same server computer both (1) provides the electronic invention disclosure form and (2) receives the filled-out invention disclosure (as indicated by the use of the term "first server computer" in both elements), and the ePAVE reference provides no such teaching or suggestion. Indeed, the Examiner has not even demonstrated any teaching in ePAVE that a server at the PTO receives any information from the ePAVE client (although this perhaps could be inferred from the cited portions of ePAVE),[1] let alone that the same server at the USPTO both (1) provides the ePAVE software and (2) receives any information relating to an invention disclosure. Hence, even assuming that (1) ePAVE could be construed as teaching the provision of an electronic disclosure form from a server computer to a client computer (which it cannot, as noted above) and (2) ePAVE could be construed as teaching the reception of a filled-out invention disclosure form at a server (which it cannot, as noted below), ePAVE still would not teach, as claim 1 requires, that the same server computer is involved in both of these operations. Moreover, any such inference would be unreasonable, since it is far more likely that the server for receiving ePAVE submissions is a specialized server, rather than a generic web server, which would have to be used to provide the ePAVE software for download.

Hence, the final Office Action fails to establish that ePAVE teaches or suggests the client-server relationship required by claim 1, and the rejection of claim 1 should be reversed for this additional reason.

[1] The final Office Action cites pages 29-31 and 49 of ePAVE as teaching "receiving a filled-out invention disclosure form on the first server." *See* Final Office Action at 3, 4. Those pages refer only to "transmitting your package to the USPTO," *e.g.*, ePAVE at 29, not to any server actually receiving the transmission.

(3) ePAVE fails to teach or suggest receiving a filled out invention disclosure in electronic form on a server and automatically converting the invention disclosure form into a format of a patent application.

Moreover, the final Office Action has not established that the ePAVE reference teaches the combination of "receiving a filled-out invention disclosure in electronic form on the first server" and "automatically converting the invention disclosure form into a format of a patent application," as required by claim 1. Instead, as noted above, the ePAVE reference specifically teaches that the ePAVE tool is designed to package a pre-prepared patent application for filing,[2] so it is difficult to see how the teachings of ePAVE could be read as either receiving a filled-out invention disclosure form or automatically converting such a form into a form of a patent application.

As noted above, the final Office Action takes the position that pages 29-31 and 49 of ePAVE teach the reception of a filled-out invention disclosure in electronic form on a server. These pages, however, fail to discuss anything more specific than "fil[ing] your submission directly with the USPTO over the Internet" (p. 29), "[t]ransmitting your [s]ubmission" and "transmit[ing] your file to the USPTO" (p. 21), and "[a]fter the package has been transmitted to the USPTO" (p. 49). None of these passages (nor anything else in the ePAVE reference) even remotely disclose that the "submission" or the "package" might be a "filled out invention disclosure in electronic form," as required by claim 1. Indeed, the whole purpose of ePAVE is for electronically filing a patent application or sequence listing, so it is reasonable only to assume that the terms "submission" and "package" mean either an application or a sequence listing, not a patent application.

Moreover, the disclosure in ePAVE of receiving a patent application cannot teach the recited reception of a filled-out invention disclosure form, because claim 1 further requires the automatic conversion of that disclosure form to a form of a patent application, which would

[2] *See also* ePAVE at 1 ("The development and public release of an electronic filing system for direct submission of . . . biotechnology listings and utility patent applications to USPTO moves the USPTO closer to attaining the goal of electronic filing of all patent applications by 2003. . . . The system will accept . . . XML-formatted utility patent specifications." (emphasis added))

not be possible if it were already a patent application. Hence, for at least this additional reason, ePAVE fails to anticipate claim 1, and the rejection of claim 1 should be reversed.

(4) ePAVE fails to disclose "automatically converting the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server."

Finally, ePAVE fails to teach or suggest either the automatic conversion of an invention disclosure form into a format of a patent application or that such conversion (if it even existed) would be performed by the ePAVE software in response to a single click input on the client and received by the server.

First, ePAVE provides no disclosure that the ePAVE software might convert an invention disclosure form to a format of a patent application, automatically or otherwise. The final Office Action argues that "ePave further teaches by click on 'Send to USPTO' button, the user's input regarding to the patent application will be filed as an electronic patent application in USPTO," Final Office Action at 3, and cites pages 18-19 and 28-29 as teaching this element. Final Office Action at 4. Pages 18 and 19 of ePAVE discuss the filing of sequence listings subsequent to the filing of an application, so it is difficult to see how these listings, filed after the application has been both created and filed, possibly could be an invention disclosure form that is converted into a format of a patent application. Pages 28 and 29 discuss details about electronic filing with the USPTO, but have nothing to do with conversion of an electronic disclosure form into a format of a patent application. Hence, the final Office Action has failed utterly to identify any teaching in ePAVE that the software might be able to convert an electronic disclosure form into a format of a patent application.

Moreover, the final Office Action appears to rely on the "Send to USPTO" button illustrated on screen shots on pages 18-19 and 28-29 as teaching "in response to a single click instruction input by the user on the first client and received by the server." However, there are two problems with this line of argument. First, as noted above, there is no indication that this button actually converts an electronic invention disclosure form into a format of a patent application, and the button's label itself indicates that the only functionality prompted by the

button is the transmission of an application to the USPTO, not the conversion of any information disclosure form. Second, claim 1 requires that the "single click instruction" is "input by the user on the . . . client and received by the server." ePAVE does not disclose this requirement, and in fact, would seem to operate in the opposite fashion: the input from the button necessarily must be received by the client (not the server), because the input instructs the client to send the submission to the server (even assuming that ePAVE teaches a server at all)—the input provides no instruction to the server itself. Consequently, the final Office Action fails to establish that ePAVE teaches this element of claim 1 either.

The final Office Action falls fall short of demonstrating that ePAVE teaches all of the elements of claim 1. In fact, the final Office Action arguably fails to establish that ePAVE teaches any of the elements of claim 1. For this reason, the Board should reverse the rejection of claim 1 under § 102 as being anticipated by ePAVE

b) Claims 38-39

Claims 38 and 39 were rejected under § 102(a) as being anticipated by ePAVE. Those claims are directed to a computer program and a computer server, respectively, and they recite elements substantially similar to those discussed above with respect to claim 1. The Appellants respectfully submit, therefore, that claims 38 and 39 are allowable over ePAVE for at least the reasons discussed above, and that the rejections of claims 38 and 39 under § 102 should be reversed as well.

c) Claims 2 and 3

Claims 2 and 3 were also rejected under § 102(a) as being anticipated by ePAVE. Claims 2 and 3 each depend from claim 1 and therefore are believed to be allowable over ePAVE for at least the reasons described above. Moreover, each of those claims recites additional limitations that are neither taught nor suggested by ePAVE and are allowable for this additional reason as well.

Claim 2 recites "active prompting of an inventor by the disclosure form to provide best modes known to the inventor for practicing an invention," while claim 3 recites "active prompting of an inventor by the disclosure form to provide detailed information required to enable one of ordinary skill to practice the invention." ePAVE teaches neither of these features. The final Office Action cites pages 17-21 and 51-52 as teaching the limitations of both claim 2 and claim 3. The cited passages, however, are bereft of any such teaching—those passages all pertain to fields provided in the user interface of the ePAVE software, but none of those fields even remotely pertains to either a best mode known to the inventor or detailed information required to enable one of ordinary skill in the art to practice the invention. Hence, the final Office Action fails to establish that ePAVE teaches the limitations of claims 2 and 3, and even if the rejection of claim 1 is affirmed, the rejections of claims 2 and 3 should be reversed.

2. The rejections of claims 4-17 under 35 U.S.C. § 103(a) should be reversed.

The office action rejected claims 4-17 under § 103(a) as being unpatentable over ePAVE, taken either alone or in combination with Hsu, Whitmyer or XML Guide. To establish a prima facie case that a claim is unpatentable under § 103, a rejection must, inter alia, show that "all claim limitations [are] taught or suggested by the prior art." MPEP § 2143.03. As noted above, ePAVE fails to teach or suggest all (or perhaps even any) elements of claim 1, so the final Office Action has not even established a prima facie case that claim 1 is unpatentable under § 103. None of the other cited references provide the disclosure missing from ePAVE, so claim 1 would be allowable over any combination of ePAVE, Hsu, Whitmyer and XML Guide:

Hsu pertains to "[a]n improved secure communication arrangement [that] separates the tasks of identify verification and certificate issuing . . ." Hsu, Abs. Hsu is cited by the final Office Action only as teaching private/public key encryption, Final Office Action at 6, and has nothing to do with invention disclosures and applications specifically. Hsu, therefore, fails to disclose any of the limitations of claim 1 missing from ePAVE..

For its part, Whitmyer "relates to a system for delivering professional services over the Internet," Whitmyer, c. 1, ll. 12-13, and generally discloses software with docketing, calendaring, and client communication functions. *See* Whitmyer, c. 3, ll. 38-65. Whitmyer is

cited by the final Office Action only as teaching generating a reminder regarding important events. Final Office Action at 7. Whitmyer does not, however, provide any teaching or suggestion of any element of claim 1.

With respect to XML Guide, "[t]he purpose of [XML Guide] is to provide you with the information needed to author structured Specification documents." XML Guide at 3. This reference is cited by ePAVE as disclosing "submitting drawings along with the electronic patent application" (although this is not an element any of claims 15-17, against which XML Guide is cited). XML Guide does discuss a manual process (which is assisted by computer software) for formatting an existing patent application in XML, but this disclosure fails to teach even the automatic conversion feature recited by claim 1, since the process disclosed by XML Guide is not automatic, as indicated by the quotation above. XML Guide provides no disclosure of any other element recited by claim 1.

Accordingly, claim 1 would be patentable over any combination ePAVE, Hsu, Whitmyer and XML Guide.. Claims 4-17 all depend from claim 1, so the Appellant respectfully submits that claims 4-17 are allowable at least by virtue of that dependence.

3. The rejection of claim 5 under 35 U.S.C. § 103(a) should be reversed.

Moreover, the final Office Action fails, with respect to several of these dependent claims, to establish even that the cited reference teaches the additional elements of those dependent claims. For example, claim 5, which was rejected under § 103(a) as being unpatentable over ePAVE, recites "wherein information in pre-selected fields of the invention disclosure form is selectively placed in a pre-selected location in said patent application." The office action takes the position that pages 18-19 and 28-29 of ePAVE disclose this feature. While those pages do illustrate fields on the ePAVE user interface, there is no teaching or suggestion in ePAVE that information in those fields is placed in a patent application at all, let alone in a pre-selected location in a patent application." The rejection of claim 5, therefore, should be reversed for this additional reason.

4. The rejection of claims 15-17 under 35 U.S.C. § 103(a) should be reversed.

Claims 15-17 stand rejected under § 103(a) as being unpatentable over the combination of ePAVE and XML Guide. The final Office Action, however, fails to establish a prima facie case that any of these claims are obvious over the cited combination. For example, claim 15 recites "providing drawing tool icons to facilitate creation of figures to be included in the filled-out invention disclosure," and neither page 26 of XML Guide (cited by the final Office Action) nor anything else in that reference teaches or suggests this element.

Similarly, neither ePAVE nor XML Guide teaches or suggests either "active prompting of the inventor by the smart disclosure form to create figures depicting novel aspects of the invention," as recited by claim 16, or "receiving as input a single click on a scan button to cause a drawing to be scanned and included as a figure in the filled-out invention disclosure form," as recited by claim 17.

In fact, the final Office Action fails to address the specific elements of claims 15-17 entirely, providing only an omnibus statement that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to allow ePave to include the function of submitting drawings along with the patent application . . . " Final Office Action at 8. This falls far short of establishing a prima facie case that any of claims 15-17 are unpatentable under § 103. Accordingly, the rejections of claims 15-17 should be rejected for this additional reason.

8. CONCLUSION

For these reasons, it is respectfully submitted that all of the rejections in the final Office Action should be reversed.

Respectfully submitted,

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9. CLAIMS APPENDIX

1. (Currently Amended) A computer-implemented method for securing intellectual property rights, the method comprising:

providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out;

actively prompting a user of the client computer to provide information corresponding to an invention into pre-selected fields of the ~~smart~~ electronic invention disclosure form;

receiving a filled-out invention disclosure in electronic form on the first server; and

automatically converting the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server.

2. (Previously Presented) The method of claim 1 further comprising:

active prompting of an inventor by the disclosure form to provide best modes known to the inventor for practicing an invention.

3. (Previously Presented): The method of claim 2 further comprising:

active prompting of an inventor by the disclosure form to provide detailed information required to enable one of ordinary skill to practice the invention.

4. (Previously Presented): The method of claim 3 further comprising:

active prompting of an inventor by the disclosure form to identify co-inventors, if any, of the invention,

wherein the disclosure form prompts an inventor to input information in pre-selected fields.

5. (Previously Presented) The method of claim 4:

wherein information in pre-selected fields of the invention disclosure form is selectively placed in a pre-selected location in said patent application.

6. (Original) The method of claim 5 wherein the single click also causes the patent application to be filed at a patent office.

7. (Original) The method of claim 6 wherein the patent application is filed at the patent office electronically.

8. (Original) The method of claim 7 further comprising:

executing the patent application with a digital signature of an inventor, assignee, or registered patent practitioner before the patent application is filed.

9. (Previously Amended) The method of claim 7 further comprising:

encrypting the patent application with a private key of the inventor, assignee, or registered patent practitioner before the patent application is filed.

10. (Original) The method of claim 9 further comprising:

maintaining a registry of public keys at the patent office; and

decrypting the patent application with a public key for the inventor, assignee, or registered patent practitioner.

11. (Original) The method of claim 7 further comprising:

transmitting notification that the patent application was filed to an intellectual property (IP) server.

12. (Original) The method of claim 11 further comprising:

automatic calendaring by the IP server of a deadline date for foreign filing under an international convention.

13. (Original) The method of claim 12 further comprising:

transmitting a reminder communication from the IP server to a specified address at a specified time period before the deadline date.

14. (Original) The method of claim 12 wherein the patent application comprises a provisional patent application and further comprising:

automatic calendaring by the IP server of a deadline date for converting the provisional patent application to a non-provisional patent application.

15. (Original) The method of claim 4 further comprising:

providing drawing tool icons to facilitate creation of figures to be included in the filled-out invention disclosure.

16. (Original) The method of claim 15 further comprising:

active prompting of the inventor by the smart disclosure form to create figures depicting novel aspects of the invention.

17. (Original) The method of claim 4 further comprising:

receiving as input a single click on a scan button to cause a drawing to be scanned and included as a figure in the filled-out invention disclosure form.

18–37. (Canceled)

38. (Currently Amended) A computer program embodied on one or more computer readable medium, the computer program comprising instructions executable by one or more computers to:

provide, from a first server computer to a client computer, an electronic invention disclosure form to be filled out;

actively prompt a user of the client computer to provide information corresponding to an invention into pre-selected fields of the electronic invention disclosure form;

~~receiving~~ receive a filled-out invention disclosure in electronic form on the first server; and

automatically convert the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server.

39. (Currently Amended) A computer server for securing intellectual property rights, the computer server comprising a processor and a computer readable medium, the computer readable medium comprising instructions executable by the processor to:

provide to a client computer an electronic invention disclosure form to be filled out;

actively prompt a user of the client computer to provide information corresponding to an invention into pre-selected fields of the electronic invention disclosure form;

receive from the client computer a filled-out invention disclosure in electronic form; and

automatically ~~converting~~ convert the invention disclosure form into a format of a patent application in response to a single click instruction input received from the user on the client computer.

10. EVIDENCE APPENDIX

None.

11. RELATED PROCEEDINGS APPENDIX

None.